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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/512,895 02/24/00 COOK

R 25791.12.02

EXAMINER

PM82/1002

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**HAYNES & BOONE**

NICHOLSON, E

ART UNIT

PAPER NUMBER

3627

DATE MAILED:

10/02/01

OCT 09 2001

**RECEIVED**

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/512,895

Applicant(s)

COOK ET AL.

Examiner

Eric K Nicholson

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claim 1, drawn to coupling a member to a preexisting structure, classified in class 166, subclass 177.4.
- II. Claims 3 and 16, drawn to an apparatus coupling a structure to an expanded member in product by process form classified in class 285, subclass 382.
- III. Claim 4, drawn to an apparatus for coupling with mating coupling arms, classified in class 285, subclass 322
- IV. Claims 2,5 and 15, drawn to a method for coupling, classified in class 29 subclass 428
- V. Claims 6, 13 and 14, drawn to an apparatus for fluid control, classified in class 137, subclass 599.
- VI. Claims 8, drawn to an apparatus having a piston in first and second chamber, classified in class 92 , subclass 61.

- VII Claims 10 drawn to coupling a member to a preexisting structure, classified in class 166, subclass 208.
- VIII. Claim 9, drawn to a method of applying an axial force, classified in class 29, subclass 888.
- IX. Claim 11, drawn to a method of operating an apparatus, classified in class 184, subclass 6.
- X. Claim 7, drawn to a method of controlling flow of, classified in class 137, subclass 1.
- XI. Claim 12, drawn to an apparatus classified in class 285, subclass 61.

Inventions I ,II,III,V,VI,VII and XI are all related as product subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility from the remaining subcombinations since invention I requires use of a shoe coupled to the tubular member with a throat passage adapted to receive a wiper dart. Invention II has separate utility from the remaining subcombinations since invention II requires use of an expanded tubular member coupled to a preexisting structure. Invention III has separate utility from the remaining subcombinations since invention III

requires use of one or more support member slots and one or more tubular member slots. Invention V has separate utility from the other remaining subcombinations since invention V requires use of valve chambers, valve elements, a centralizer, a radial expansion assembly or a preload assembly.

Invention VI has separate utility from the other subcombinations since invention VI requires use of an annular piston assembly in an annular chamber. Invention

VII has separate utility from the other subcombinations since invention VII requires use of a body of lubricant positioned in an annular chamber defined by the space between a sealing member, an annular member and a tubular member.

Invention XI has separate utility from the other subcombinations since invention XI requires use of a compressed spring coupled to the support member and a spacer to control the spring compression. See MPEP § 806.05(d).

Inventions IV, VIII, IX and X are all related as method subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility from the remaining subcombinations since invention IV requires use of injecting a first and second quantity of fluidic material above and below an expansion cone. Invention VIII has separate utility from the

remaining subcombinations since invention VIII requires use applying an axial force to a first piston using a second piston in a first piston chamber. Invention IX has separate utility from the remaining subcombinations since invention IX requires use of lubricating the interface between an expansion cone and a tubular member and applying a substantially constant axial force to the tubular member prior to beginning an expansion process. Invention X has separate utility from the remaining subcombinations since invention X requires use of injecting fluidic materials into an inlet passage and blocking a inlet passage and opening an outlet passage.

The inventions are distinct, each from the other because of the following reasons:

Inventions (IV,VIII,IX,X) and (I,II,III,V,VI,VII,XI) are related as process and apparatus for its practice or product made. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus or product made as claimed can be used to practice or be made by another and materially different process. (MPEP § 806.05(e)). In this case the processes as claimed can be practiced by another materially different apparatus or make materially different products.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

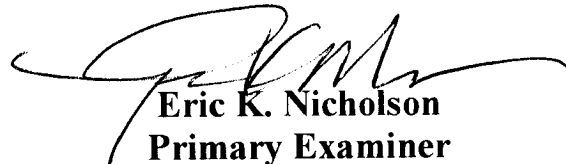
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bethanne Dayoan, can be reached on (703) 308-3865. The fax phone number for Technical Center 3600 is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center receptionist whose telephone number is (703) 308-2168.

ekn

9/27/01



**Eric K. Nicholson**  
**Primary Examiner**  
**Technology Center 3600**

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

## INFORMATION ON HOW TO EFFECT DRAWING CHANGES

### 1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

### 2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

#### Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.